

LA RUSSA'S LOOPHOLE: TRADEMARK INFRINGEMENT LAWSUITS AND SOCIAL NETWORKS

I. INTRODUCTION

The St. Louis Cardinals are no strangers to tragedy and embarrassing media coverage.¹ In 2002, the team suffered a terrible loss when Darryl Kile, “a former 20-game winner and one of the most respected players in the St. Louis clubhouse,” was found dead in his hotel room.² Just five years later, in April 2007, the sudden death of former Cardinals’ relief pitcher Josh Hancock followed.³ Finally, in March 2007, the St. Louis Cardinals faced embarrassment when team manager Tony La Russa was “found sleeping behind the wheel of a sports utility vehicle during spring training with a blood alcohol level of 0.093 percent.”⁴ These events were rehashed in 2009, when Tony La Russa’s name was “twitterjacked.”⁵ Thereafter, on May 6, 2009, Tony La Russa filed suit against the social networking site Twitter, claiming various injuries resulting from the “twitterjacking.”⁶

1. See generally Stephen Cannella, *Kile Found Dead in Chicago Hotel Room*, CNN.SI.COM, June 22, 2002, http://sportsillustrated.cnn.com/baseball/news/2002/06/22/cards_kile_ap (describing circumstances of Kile’s death); see also NBC Sports, *Lawyer Denies Twitter “Payoff” to La Russa*, <http://nbcports.msnbc.com/id/31780329> (last visited March 22, 2010) [hereinafter “NBC Report”] (reporting death of Cardinals’ pitchers Darryl Kile and Josh Hancock).

2. Cannella, *supra* note 1 (“Cardinals pitcher Darryl Kile died of a heart condition in his Chicago hotel room in 2002.”).

3. See NBC Report, *supra* note 1 (“Cardinals reliever Josh Hancock died in an auto accident in April 2007, and the medical examiner measured his blood-alcohol level at 0.157 – nearly twice the legal limit.”).

4. *Id.*

5. See generally Douglas MacMillan, *La Russa vs. Twitter Tests Web Anonymity*, BUS.WEEK, June 10, 2009, available at http://www.businessweek.com/technology/content/jun2009/tc2009069_767898.htm (detailing La Russa lawsuit). Twitter’s policy details the terms of use in regard to impersonation, trademark policy, and name squatting. See Twitter.com, Impersonation Policy, <http://help.twitter.com/forums/26357/entries/18366> (last visited July 28, 2009) [hereinafter “Impersonation Policy”] (outlining Twitter’s impersonation policy). “Twitterjacking” is a term created to describe instances of identity theft when a user registers using the name of a celebrity, thus making posts under false pretenses. See William Sloan Coats et al., *Right of Publicity: Who, What, When, Where, Why, and More Importantly, How Much?*, 985 PLI/PAT 271, 284 (2009) (discussing impact of new technology of right of publicity claims).

6. See Complaint for Trademark Infringement, False Designation of Origin, Trademark Dilution, Cybersquatting, Misappropriation of Name, and Misappropriation of Likeness, *La Russa v. Twitter, Inc.*, No. 09-488101 (filed May 06, 2009) [hereinafter “Complaint”] (alleging harm caused by Twitter against La Russa).

Twitter is a free online social network that allows users to post and read messages, called “tweets.”⁷ Users may make postings under “any name they wish, real or imagined, so long as they make it clear if they’re impersonating someone.”⁸ In essence, Twitter allows users to answer the simple question, “What are you doing?” in 140 characters or less, and share their answers with others.⁹ Created in 2006, “Twitter has grown into a real-time short messaging service that works over multiple networks and devices.”¹⁰ Since its release, Twitter has risen in the ranks of popular social networks, rubbing elbows with Facebook and MySpace.¹¹ Unfortunately for Twitter, this increasing popularity also produced mounting legal claims against it.¹² Although La Russa is the first to file suit against Twitter based on an instance of “twitterjacking,” other popular figures including the Dalai Lama and Kanye West, have shared similar experiences.¹³

The complaint contained claims of both tortious actions and intellectual property infringements. *See id.*

7. *See* Twitter.com, Twitter Support: Frequently Asked Questions, <http://help.twitter.com/forums/10711/entries/13920> (last visited Sept. 23, 2009) (“Twitter is a service for friends, family, and co-workers to communicate and stay connected through the exchange of quick, frequent messages. People write short updates, often called “tweets” of 140 characters or fewer. These messages are posted to your profile or your blog, sent to your followers, and are searchable on Twitter search.”).

8. MacMillan, *supra* note 5. Twitter Policy details terms of use in regard to impersonation, trademark policy, and name squatting. For full text see Impersonation Policy, *supra* note 5 (detailing Twitter’s impersonation policy); Twitter.com, Trademark Policy, <http://help.twitter.com/forums/26257/entries/18367> (last visited July 28, 2009) [hereinafter “Twitter Trademark Policy”] (detailing Twitter’s trademark policy); Twitter.com, Name Squatting, <http://help.twitter.com/forums/26257/entries/18370> (last visited July 28, 2009) [hereinafter “Twitter Name Squatting Policy”] (detailing Twitter’s Name Squatting Policy).

9. *See* Jennifer Archie, et al., *Protecting Your Rights in 140 Characters or Less: Trademark Protection on Twitter*, 21 NO. 11 INTELL. PROP. & TECH. L.J. 23, 23 (2009) (describing Twitter).

10. Twitter.com, About Us, <http://twitter.com/about#about> (last visited Sept. 23, 2009).

11. *See* Andy Kazeniak, *Social Networks: Facebook Takes Over Top Spot, Twitter Climbs*, Feb. 9, 2009, <http://blog.compete.com/2009/02/09/facebook-myspace-twitter-social-network> (depicting popularity of Facebook and Twitter).

12. *See generally* Lori E. Lesser, *Social Networks and Blogs*, 962 PLI/PAT 23, 28 (2009) (“Despite their success, social networking sites and blogs present new legal issues as they face challenges from legislators, state attorneys general, users and content owners over issues including invasion of privacy, copyright and trademark infringement and defamation.”).

13. *See* MacMillan, *supra* note 5 (reporting instances of celebrities other than La Russa who have experienced trouble with Twitter and false accounts). Initially, Twitter suspended the false Dalai Lama site but it “later reappeared with the name ‘the UNOFFICIAL Twitter page of His Holiness the Dalai Lama.’” *Id.* Further, the postings set up under the name of Kanye West were removed after Kanye West complained “on his personal blog about an imposter posing as him, and called

The claims addressed in La Russa's suit arose after an anonymous user falsely created a Twitter account page under La Russa's name.¹⁴ The page contained postings making light of the previously mentioned tragedies and embarrassments faced by the St. Louis Cardinals.¹⁵ The complaint emphasizes that:

The Site states in large lettering, 'Tony La Russa is using Twitter,' and encourages users to 'Join today to start receiving Tony La Russa's updates.' It also contains a picture of Plaintiff with his name printed next to it. Beneath the picture, the Site contains written entries that are impliedly written by Plaintiff himself when in fact they are not.¹⁶

Finally, in the user profile, the false anonymous user noted that, "Bio Parodies are fun for everyone."¹⁷

Twitter 'irresponsible and deceitful' for not doing anything to stop it." *Id.* Other "twitterjacked" celebrities include "Tina Fey, Christopher Walken, Condoleeza Rice, and Bill Gates." Coats et al., *supra* note 5, at 284; see also Joshua Rhett Miller, "Twitterjacking" – Identity Theft in 140 Characters or Less, FOXNEWS.COM, May 1, 2009, <http://www.foxnews.com/story/0,2933,518480,00.html> (providing list of several celebrity victims of "twitterjacking"). In the sports world:

Eagles CB Asante Samuel last month Tweeted a Super Bowl guarantee that was reported locally, but Samuel "didn't have a Twitter account." Cowboys DE DeMarcus Ware and Steelers QB Ben Roethlisberger also supposedly made comments via Twitter despite not having an actual account. As of Friday, there were "10,848 people 'following' a fake account under" Colts QB Peyton Manning's name, while "another 17,084 were following a fake" account under Giants QB Eli Manning's name.

Sports Media, *Tony La Russa Settles Lawsuit Against Twitter Out of Court*, STREET & SMITH'S SPORTS BUSINESS DAILY, June 8, 2009, <http://www.sportsbusinessdaily.com/article/130769>.

14. See Zusha Elinson, *Twitter Says It Will Fight La Russa Suit Over Fake Tweets*, LAW.COM, June 09, 2009, <http://www.law.com/jsp/law/LawArticleFriendly.jsp?id=1202431321477> (addressing La Russa's issue with Twitter).

15. See *id.* (describing false La Russa Twitter page). The postings were as follows:

Lost 2 out of 3, but we made it out of Chicago without one drunk driving incident or dead pitcher . . . I'd call that a 1-55 series. 8:01 PM Apr. 19th from web;

Fortunately, Ian Snell sucks now . . . when Molina and Duncan Jr. go deep of you its time to look yourself in the mirror, have an ice . . . 3:33 PM Apr 8th from web; Drinking a cold Zima and wishing fucking Hancock was alive, I bet he could've gotten Jack Wilson out. 4:13 PM Apr 7th from web.

Complaint, *supra* note 6.

16. William McGeeveran, *Celebrity Impersonation and Section 230*, INFO/LAW, June 25, 2009, <http://blogs.law.harvard.edu/infolaw/2009/06/25/impersonation-and-230> (explaining purpose of complaint's emphasis was due to Tony LaRussa's likelihood of prevailing on trademark infringement claim depending his ability to prove the phony account was likely to confuse consumers into believing LaRussa endorsed Twitter).

17. *Id.* There were only four followers to the false account, which could have caused a multitude of problems for La Russa's claims. See *id.* (detailing underlying facts of La Russa suit).

Upset by the page content, La Russa contacted Twitter and asked that the page be shut down.¹⁸ Allegedly, Twitter ignored La Russa's complaints, and La Russa responded by filing the first ever legal challenge against the site.¹⁹ After the suit was filed, Twitter removed the case to federal court, followed by La Russa's motion to dismiss the suit with prejudice in June 2009.²⁰

Despite its dismissal, the La Russa suit is unique in comparison to the legal suits endured by social networks in the past.²¹ Most notably, La Russa's suit not only addresses tort-based legal claims, but also addresses claims of trademark infringement against a social network.²² La Russa filed suit for the following causes of action: (1) trademark infringement; (2) false designation of origin; (3) trademark dilution; (4) cybersquatting; (5) misappropriation of name; (6) misappropriation of likeness; (7) invasion of privacy; and, (8) intentional misrepresentation.²³ Most of La Russa's allegations are well established in intellectual property and tort law.²⁴ Cybersquatting, however, is a relatively new concept that is gaining attention as Internet popularity grows.²⁵

18. See Elinson, *supra* note 14 (reporting La Russa's actions upon discovery of false Twitter page).

19. See *id.* (addressing La Russa using filing suit after notifying Twitter of fraud without reply).

20. See Notice of Dismissal, *La Russa v. Twitter, Inc.*, No. 09-2503 (filed June 2009). The Dismissal was filed pursuant to rule 41(a)(1)(A) of the Federal Rules of Civil Procedure. *Id.*

21. See McGeeveran, *supra* note 16 (marking La Russa's suit against Twitter as novel in certain aspects).

22. See *id.* (noting that complaint makes trademark claims which are not often used). In general, tort-based claims are a more popular and well established law in conjunction with social network liability, whereas, claims pertaining to trademark infringement are a more rare and less explored area of law when against social networks. See *id.* (describing popularity of tort-based claims against social networks as opposed to trademark infringement claims).

23. See Complaint, *supra* note 6 (listing La Russa's claims against Twitter).

24. See *id.* (listing allegations). Those claims alleged by La Russa that are well established law are the claims of trademark infringement and dilution, misappropriation of name and likeness, invasion of privacy, and intentional misrepresentation. Steven Seidenberg, *Names' Sake: Social Media Pose Trademark Threats for Companies*, INSIDE COUNCIL, Sept. 1, 2009 at 24, available at <http://www.insidecounsel.com/Issues/2009/September%202009/Pages/Names-Sake.aspx>.

25. See Seidenberg, *supra* note 24 ("There are clear rules and legal procedures for resolving cybersquatting and other domain name disputes, but the law hasn't yet caught up to social media."); see also Peter S. Sloane & Laura J. Winston, *Trademarks and Copyrights as Growth Opportunities Even in a Recessionary Economy*, INT'L PROP. TODAY, May 2009, at 30, available at http://www.leasonellis.com/The_Business_of_Trademarks_and_Copyrights.pdf.pdf ("A record 2,156 complaints alleging cybersquatting were filed with the World Intellectual Property Organization, representing an 18% increase over 2006 and a 48% increase over 2005.").

In the following sections, this Comment provides an overview of the laws governing many popular claims against social networks with a strong focus on the claims raised by La Russa. In Section II, this Comment addresses background issues surrounding La Russa's claims.²⁶ The background includes, not only the laws pertaining to his case, but also methods adopted by social networks, dealing with similar issues.²⁷ In Section III, this Comment analyzes several legal issues affecting La Russa's case.²⁸ Finally, Section IV addresses the possible impact claims similar to La Russa's suit may have on the legal treatment of social networks in the future.²⁹

II. BACKGROUND

Typically, in lawsuits against Internet service providers, the general issues that arise include tort claims and intellectual property violations.³⁰ Congress has addressed many of these legal issues by passing the Communications Decency Act ("CDA"), the Digital Millennium Copyright Act ("DMCA"), and the Anticybersquatting Protection Act ("ACPA").³¹ Courts have carefully interpreted most provisions of the CDA and DMCA.³² The ACPA, however, has few

26. For a background of LaRussa's claims, see *infra* text and accompanying notes 30-142.

27. For discussion of social networks and the law, see *infra* text and accompanying notes 30-142.

28. For an analysis of the legal issues, see *infra* text and accompanying notes 143-221.

29. For a conclusion of the comment, see *infra* text and accompanying notes 222-228.

30. See Lesser, *supra* note 12, at 34 (discussing Communications Decency Act and Digital Millennium Copyright Act). Most tort claims against social networks have included defamation allegations. See *id.* at 38 (considering tort claims against social networks).

31. See *id.* (discussing DMCA and CDA as applied to legal issues involving copyright and trademark law); see also Communications Decency Act, 27 U.S.C. § 230(b)(2)(1998) [hereinafter "CDA"] (providing provisions of CDA); Digital Millennium Copyright Act, 17 U.S.C. § 512 (1999) [hereinafter "DMCA"] (providing provision of DMCA); Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (2006) [hereinafter "APCA"] (providing provisions of ACPA). The ACPA is also known as the Trademark Cyberpiracy Prevention Act. See *id.* (stating alternative names of act); see also Allison E. Horton, *Beyond Control?: The Rise and Fall of Defamation Regulation on the Internet*, 43 VAL. U. L. REV. 1265, 1305 (2009) (discussing Congressional intent behind CDA); Eric Goldman, *The Law of Social Networking Sites: A Primer*, <http://technology.findlaw.com/articles/01189/010830.html> (last visited March 22, 2010) (listing cases citing CDA and DMCA); Hillel I. Parness, *Toward "Social Networking Law"?*, 1 No. 4 *Landslide* 13, 13 (March/April 2009) ("At the dawn of the Internet's popularity, various judicial decisions regarding property rights and personal liberties in the context of the Internet caused Congress to adopt certain legislation.").

32. See Lesser, *supra* note 12, at 29 (discussing court interpretation of CDA and DMCA).

interpretive cases to provide direction in this relatively new area of law.³³ Because ACPA litigation remains uncharted territory, there is room for creative liability arguments, as was the case in *La Russa v. Twitter*.³⁴

A. New Issues Originating With Growing Popularity of Internet

When drafting the CDA and DMCA, Congress was wary about the potential effects of extensive government regulation of the internet.³⁵ As a result, the language of this new legislation encourages self-regulation, as opposed to creating an overbearing regulatory presence.³⁶ However, Congress found it extremely difficult to craft the final bill, because of the extensive differences between the Internet and traditional media forms.³⁷

First, the costs of using the Internet are significantly lower than traditional media forms, “such as television, radio, newspapers, and magazines.”³⁸ The Internet’s bargain transaction cost of providing an easy “way for a speaker to reach a large audience,” makes the Internet an attractive option to network, and advertize.³⁹ As such, “unlike traditional media, the barriers to entry as a speaker on the Internet do not differ significantly from the barriers to entry as a listener.”⁴⁰ Second, the Internet’s youth leaves legality of many

33. See generally ACPA, *supra* note 31, at § 1125(d) (enumerating statutory requirements bounding anticybersquatting law and year of effectiveness).

34. For full discussion of this law, see *infra* text accompanying notes 202-209.

35. See *Zeran v. Am. Online*, 129 F.3d 327, 330 (4th Cir. 1997) (“Congress recognized the threat that tort-based lawsuits pose to freedom of speech . . . [and] Section 230 was enacted, in part, to maintain the robust nature of Internet communication and, accordingly, to keep government interference in the medium to a minimum.”); see CDA, *supra* note 31, § 230(b)(2) (“It is the policy of the United States . . . to preserve the vibrant and competitive free market that presently exists for the Internet and other interactive computer services, unfettered by Federal or State regulation.”); *Zeran*, *supra* at 330-31 (“Congress made a policy choice, however, not to deter harmful online speech through the separate route of imposing tort liability on companies that serve as intermediaries for other parties’ potentially injurious messages.”).

36. See *Horton*, *supra* note 31, at 1305 (“The CDA’s purpose is to promote self-help on the Internet and prevent the potential chilling effect that regulation may have on Internet speech.”); see also *Blumenthal v. Drudge*, 992 F. Supp. 44, 52 (D.C. Cir. 1998) (“Congress has conferred immunity from tort liability as an incentive to Internet service providers to self-police the Internet for obscenity and other offensive material, even where the self-policing is unsuccessful or not even attempted.”).

37. See *Blumenthal*, *supra* note 36, at 52 (comparing differences between traditional media, including print, television and radio broadcasts, and the internet).

38. *Am. Civil Liberties Union v. Reno*, 929 F. Supp. 824, 843 (E.D. Pa. 1996).

39. *Id.*

40. *Id.*

questionable *e-activities* either unexplored or explored and unavailable to the public.⁴¹ In turn, this causes confusion among web users about the legality of their actions.⁴² Third, because domain names are unique to Internet media, they are a more limited resource in contrast to “visual and verbal trademarks.”⁴³ Finally, unlike traditional media that seeks out the population to maintain sales and ratings, an Internet *user* “has to seek out information through a time-consuming process of typing and clicking . . . to enjoy the benefits of cyberspace communication.”⁴⁴ Congress created both the CDA and DMCA with these factors in mind.⁴⁵

B. Communications Decency Act of 1996

Section 230 of the CDA was Congress' reaction to a 1995 case, *Stratton Oakmont, Inc. v. Prodigy Servs. Co.*⁴⁶ *Stratton* concerned Prodigy Services Company, an Internet service that allows others to post messages on its site.⁴⁷ The court reasoned that because Prodigy voluntarily removed several “offensive” postings from its site, it was liable for any “defamatory messages that it failed to delete.”⁴⁸ The

41. See Jon H. Oram, *Will the Real Candidate Please Stand Up?: Political Parody on the Internet*, 5 J. INTELL. PROP. L. 467, 522 (1998) (speaking to novelty of Internet and lack of legal precedent concerning conduct on Internet sites).

42. See *id.* (explaining legal ambiguity with respect to Internet conduct, and restricted behavior is attributed to Internet law's infancy).

43. *Id.*

44. *Id.* Arguably, however, the time consumption of Internet searches has decreased due to growing user familiarity with and the proficiency of search engines, which do most of the legwork for the user. See, e.g., Internet World State, North America Internet Usage Statistics, Population and Telecommunications Reports, <http://www.internetworldstats.com/stats14.htm> (last visited Sept. 23, 2009) (reporting 73.9% of Americans uses internet, with 138.7% growth from 2000-2009); see also SearchEngineWatch.com, Survey: Searchers are Confident, Satisfied & Clueless – Search Engine Watch (SEW), <http://searchenginewatch.com/3462911> (Last visited Sept. 23, 2009) (providing statistics of American trend in internet searches, including, “87% of online searchers say they have successful search experiences most of the time, including 17% of users who say they always find the time, including 17% of users who say they always find the information for which they are looking”).

45. For full discussion of CDA and DMCA, see *infra* notes 46-83.

46. See Lesser, *supra* note 12, at 34 (discussing history of CDA and cases leading up to its enactment); *Stratton Oakmont, Inc. v. Prodigy Servs. Co.*, 1995 WL 32371 (N.Y. Sup. Ct. May 24, 1995) [hereinafter “*Stratton Oakmont*”] (providing backdrop of CDA enactment); CDA, *supra* note 31, at § 230(c). Note that Congress chose to title this section that provides broadened protection to Internet network providers, “Protection for ‘Good Samaritan’ blocking and screening of offensive material.” Lesser, *supra* note 11, at 34.

47. See *Stratton Oakmont*, 1995 WL 323710 (1995) (detailing facts of case).

48. Lesser, *supra* note 12, at 34. The court held that Prodigy employed an editorial function when it removed the postings, and was, therefore, treated as a

holding in *Stratton* did not sit well with lawmakers.⁴⁹ Based on the *Stratton* ruling, companies that are less socially responsible would escape liability.⁵⁰ Therefore, Congress enacted Section 230 of the CDA, which applies to all Internet publishers or speakers.⁵¹ It states that, “[n]o provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.”⁵² In other words, an Internet service provider, like Prodigy, is not liable for tort or state based claims because it employs an editorial function.⁵³ Although Prodigy would have been free from liability, Section 230 does not afford the original posters of the defamatory material the same luxury of immunity (if the true identity of those posters is discoverable).⁵⁴

Section 230 is not all encompassing, however, and there is a limit to the shelter created.⁵⁵ It exempts federal criminal liability, intellectual property law, and any state laws that are “consistent with this section” from coverage under the section.⁵⁶ Therefore, this limitation provides a loophole for “celebrities who can recast privacy-like claims under trademark law (and possibly also rights of publicity, if those are interpreted as intellectual property under the language of Section 230(d)).”⁵⁷

C. The Digital Millennium Copyright Act (“DMCA”)

Section 512 of the DMCA offers Internet service providers with a “safe harbor” from monetary damages for claims of copyright infringement, an area otherwise left vulnerable under Section 230 of

publisher of a newspaper. *See id.* (describing rationale for holding internet service liable).

49. *See id.* at 35 (discussing rationale for creating Section 230 of CDA after *Stratton*).

50. *See id.* (highlighting problems with *Stratton* holding).

51. *See id.* (noting protection provided by CDA to Internet service providers).

52. CDA, *supra* note 31, at § 230(c)(1).

53. *See* Anne H. Hocking, *Selected Liability Issues – Social Networks and Blogs*, 947 PLI/PAT 187, 197 (2008) (discussing immunities provided to internet service providers). This includes editing out material that may technically be constitutionally protected. *See id.* (detailing immunities provided to internet services providers).

54. *See* *Zeran v. Am. Online*, 129 F.3d 327, 330 (4th Cir. 1997) (“None of this means, of course, that the original culpable party who posts defamatory messages would escape accountability.”).

55. *See* CDA, *supra* note 31, at § 230(d) (enumerating limits to Section 230 shelter).

56. *Id.*

57. McGeeveran, *supra* note 16.

the CDA.⁵⁸ Section 512 “immunizes [Internet service providers, in general,] from liability for contributory or vicarious copyright liability for infringing third-party content under a defined set of safe harbors.”⁵⁹ Nevertheless, if social networking sites or blogs actively maintain their networks rather than acting merely as passive networks, the provider “*could* be found liable for contributory, vicarious, or inducement of copyright infringement committed by users on their websites.”⁶⁰ Therefore, Section 512 protects Internet service providers from “liability for infringing material appearing on their systems” only under certain circumstances.⁶¹ To qualify for the safe harbor, a service provider must:

(a)[Adopt] and reasonably [implement], and [inform] subscribers and account holders of the service provider’s system or network of, a policy that provides for termination in appropriate circumstances of subscribers and account holders of the service provider’s system or network who are repeat infringers; and (b)[accommodate] and [] not interfere with standard technical measures.⁶²

The DMCA, however, does not require that Internet service providers follow these guidelines stringently, only that they act reasonably.⁶³ Although the policy requirements are relatively flexible, the “safe harbor” provided to an Internet service provider does have limitations.⁶⁴ Under Section 512(c)(1)(A)(iii), the “safe harbor” may be limited if the network “upon obtaining . . . knowledge or awareness [of infringing activity, does not act] expeditiously to remove, or disable access to the material.”⁶⁵ Therefore, an Internet service provider may only enjoy the “safe harbor” provided by the

58. See Jeffrey D. Neuburger, *Technology, the Internet and Electronic Commerce: Staying Interactive in the High-Tech Environment, A Summary of Recent Developments in the Law*, 927 PLI/PAT 699, 729 (2008) (discussing DMCA safe harbor provisions). The safe harbor is included in Section 512(c) of the DMCA. *Id.*

59. Lesser, *supra* note 12, at 51.

60. *Id.* at 52 (emphasis added). The active maintenance mentioned can take a variety of forms including editorial functions. *Id.*

61. Neuburger, *supra* note 58, at 729.

62. Digital Millennium Copyright Act, 17 U.S.C. § 512(i)(1)(A)-(B).

63. See *Io Group, Inc. v. Veoh Networks, Inc.*, 586 F. Supp. 2d 1132, 1144 (N.D. Cal. 2008) (“[T]he mere fact that [the repeat infringer] appeared on [the internet service provider site] under a different user name and identity does not, by itself create a legitimate question of fact regarding the procedural implementation of [that internet service provider’s] policy” (quoting *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1104 (W.D. Wash. 2004))). For a list of cases analyzing DMCA guidelines, see *infra* note 73.

64. See 17 U.S.C. § 512(c)(1)(A)-(C) (listing limitations on safe harbor).

65. *Id.* § 512(c)(1)(A)(iii).

DMCA so long as the provider advertises a policy against copyright infringements and makes a realistic threat of shutting down account access to those who go against the policy.⁶⁶

D. Federal Court Interpretations of the CDA and DMCA

After the enactment of the CDA and DMCA, courts began interpreting the legislative language in an ever-expanding number of cases.⁶⁷ In 1997, *Zeran v. America Online*, tested the immunity provided to a service provider via Section 230 of the CDA.⁶⁸ The Fourth Circuit concluded that Congress had the following rationale when drafting Section 230;

It would be impossible for service providers to screen each of their millions of postings for possible problems. Faced with potential liability for each message republished by their services, interactive computer service providers might choose to severely restrict the number and type of messages posted.⁶⁹

Therefore, the court determined that creating liability upon notice would have “a chilling effect on the freedom of Internet speech.”⁷⁰

In 1998, the D.C. Circuit expanded on the immunities described in *Zeran* when deciding *Blumenthal v. Drudge*.⁷¹ Despite America Online’s (AOL) showing that the individual making defamatory posts was on its payroll to make the postings, the court determined that AOL retained its immunity as an Internet service provider.⁷² In the following years, several cases cited *Zeran* as au-

66. See Lesser, *supra* note 12, at 55-56 (discussing DMCA safe harbor).

67. See *id.* at 56 (listing cases citing CDA and DMCA).

68. See *Zeran v. Am. Online*, 129 F.3d 327, 328 (4th Cir. 1997) (discussing proper use of CDA in holding).

69. *Id.* at 331.

70. *Id.* at 333.

Because service providers would be subject to liability only for the publication of information, and not for its removal, they would have a natural incentive simply to remove messages upon notification, whether the contents were defamatory or not. . . . Thus, like strict liability, liability upon notice has a chilling effect on the freedom of Internet speech.

Id. (citing *Philadelphia Newspapers, Inc. v. Hepps*, 475 U.S. 767, 777 (1986)).

71. *Blumenthal v. Drudge*, 992 F. Supp. 44, 52-3 (D.C. Cir. 1998); *Zeran*, 129 F.3d 327; see also Horton, *supra* note 31, at 1287-88 (2009) (discussing holding in *Blumenthal*).

72. See *Blumenthal*, 992 F. Supp. at 52-53 (“While it appears to this Court that AOL in this case has taken advantage of all the benefits conferred by Congress in the [CDA], and then some, without accepting any of the burdens that Congress

thority, thus reaffirming the *Zeran* court's findings.⁷³ Finally, in 2001, the Southern District of New York affirmed that the CDA does not provide immunity to Internet service providers from trademark infringement claims in *Gucci Am., Inc. v. Hall & Assoc.*⁷⁴

The affirmation in *Gucci* gave rise to several cases triggering the DMCA safe harbors.⁷⁵ In 2001, the Central District of California used a textualist interpretation method of the DMCA to determine safe harbor qualifications in *Hendrickson v. eBay*.⁷⁶ In doing so, the court held that a notice of infringement to eBay must "comply substantially" with the direct language of the DMCA to remove the safe harbor protection.⁷⁷ The District of Maryland, in *Costar*

intended, the statutory language is clear: AOL is immune from suit . . ."); *see also* Horton, *supra* note 31, at 1287-88 (explaining *Blumenthal* ruling).

73. *See, e.g.*, *Perfect 10, Inc. v. CCBill*, 488 F.3d 1102, 1118-19 (9th Cir. 2007) (citing *Zeran* and holding Google immune from liability); *Carafano v. MetroSplash.com Inc.*, 339 F.3d 1119, 1120-21 (9th Cir. 2003) (holding Matchmaker.com immune from suit concerning false content in dating profiles); *Doe v. MySpace, Inc.*, 474 F. Supp. 2d 843, 847-48 (W.D. Tex. 2007) (citing *Zeran* and holding MySpace immune from civil liability despite allegedly knowing about postings of child pornography); *Parker v. Google Inc.*, 422 F. Supp. 2d 492, 501 (E.D. Pa. 2006) (citing *Zeran* and holding Google immune from liability even after receiving notice of defamatory material); *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1118 (W.D. Wash. 2004) (quoting *Zeran* and holding Amazon.com immune from state law claims despite encouraging vendors to post content and images because vendors decide what is posted, not Amazon.com); *Blumenthal*, 992 F. Supp. at 51 (quoting *Zeran* and holding America Online not to be "internet content provider" despite having editorial function over alleged infringing material); *Barrett v. Rosenthal*, 146 P.3d 510, 529 (Cal. 2006) (holding immunity applies to distributors as well as publishers).

74. *See Gucci Am., Inc. v. Hall & Assoc.*, 135 F. Supp. 2d 409, 412 (S.D.N.Y. 2001) ("Nothing in this section shall be construed to limit or expand any law pertaining to intellectual property.") (quoting CDA, 47 U.S.C. § 230(e)(2)(1998)).

75. *See, e.g.*, *Perfect 10*, 488 F.3d at 1111 (9th Cir. 2007) ("A service provider reasonably implements its repeat infringer policy if it terminates users when 'appropriate.' Section 512(i) itself does not clarify when it is 'appropriate' for service providers to act. It only requires that a service provider terminate users who are 'repeat infringers.'"); *Io Group, Inc. v. Veoh Networks, Inc.*, 586 F. Supp. 2d 1132, 1144 (N.D. Cal. 2008) ("[T]he mere fact that [the repeat infringer] appeared on [the internet service provider site] under a different user name and identity does not, by itself create a legitimate question of fact regarding the procedural implementation of [that internet service provider's] policy."); *CoStar Group, Inc. v. Loopnet, Inc.*, 164 F. Supp. 2d 688, 703 (D. Md. 2001) ("This requirement is designed so that flagrant repeat infringers, who 'abuse their access to the Internet through disrespect for the intellectual property rights of others should know there is a realistic threat of losing . . . access.'").

76. *See Hendrickson v. eBay, Inc.*, 165 F. Supp. 2d 1082, 1088 (C.D. Cal. 2001) (discussing safe harbor provision); *see also* 17 U.S.C. § 512(c)(3) (listing requirements constituting proper notice).

77. *See Hendrickson*, 165 F. Supp. 2d at 1092-93 (discussing court's rationale for DMCA provision requirements); *see also* 17 U.S.C. § 512(c)(3)(B)(i) (stating that notification to Internet service providers must "comply substantially" with listed elements in order to find that provider "has actual knowledge or is aware of

Group v. Loopnet, further expanded on the DMCA interpretations.⁷⁸ An Internet service provider's "policy must warn users who repeatedly infringe copyrights that there is a 'realistic threat' of losing account access."⁷⁹ Further, the Western District of Washington, in *Corbis v. Amazon.com*, held that:

(1) a termination policy need not eliminate all infringers in order to be 'reasonably implemented'; (2) repeated 'takedown' notices alone are not sufficient to trigger termination obligation; and (3) implementation details of the termination policy need not be communicated to users.⁸⁰

Finally, in *Doe v. MySpace*, the Western District of Texas extended the CDA and DMCA immunities to include social networks.⁸¹ These cases reflect the changing ways people use and interact with the Internet.⁸² As these types of changes persist, courts will continue to test Congressional legislation.⁸³

E. Cybersquatting

In Tony La Russa's complaint, he raised a cybersquatting claim; a claim with questionable application to Twitter as a social network.⁸⁴ Cybersquatting is a civil liability borne by "any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without the person's consent, with the specific intent to

the facts or circumstances from which infringing activity is apparent"). eBay is an Internet forum that acts as a "marketplace" for its users to buy and sell products online. eBay, Who We Are – eBay Inc., <http://www.ebayinc.com/who> (last visited Oct. 17, 2009). The court determined that the plaintiff did not provide proper notice to eBay because the notice did not substantially comply with the provisions listed in Section 512 of the DMCA. *Hendrickson*, 165 F. Supp. 2d at 1093. This holding provided that, although there is some flexibility in the proper form of notice, there still must be some conformance with the DMCA's guidelines. *Id.*

78. See *Costar*, 164 F. Supp. 2d at 703 (expanding on DMCA requirements).

79. Lesser, *supra* note 12, at 56 (citing holding in *Costar*).

80. *Id.* (citing holding in *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090 (W.D. Wash. 2004)).

81. See *Doe v. MySpace, Inc.*, 474 F. Supp. 2d 843, 847 (W.D. Tex. 2007) (holding that social networks were included in immunities provided by Section 230). The court also noted that Section 230 affords immunities to Internet service providers for claims other than defamation. *Id.* at 849.

82. See Sloane, *supra* note 25, at 30 (discussing new issues arising with new Internet uses).

83. See *id.* (discussing existence of many new issues yet to arise due to amount of new litigations pending internationally).

84. See Complaint, *supra* note 6 (stating that Twitter should be included within scope of cybersquatting liability).

profit from such name by selling the domain name for financial gain.”⁸⁵ These disputes arise not only because there are a finite number of domain names, but also because those domain names are registered on a first come first serve basis.⁸⁶ Without regulatory protection, the field would be left open not only to those trying to capitalize on opportunity but also those innocently registering for other reasons.⁸⁷ There are many kinds of cybersquatters, all of whom are liable.⁸⁸ Therefore, those who feel their rights have been infringed upon can look to either of two different instruments to protect those rights.⁸⁹ These two instruments, established in late 1999, are “the Anticybersquatting Protection Act (ACPA), enacted by the U.S. Congress. . . and the Uniform Dispute Resolution Policy (UDRP), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN).”⁹⁰

1. *Anticybersquatting Protection Act*

An amendment to the Lanham Act, the ACPA imposes civil liability on those who take part in “act[s] of registering, trafficking

85. Dale M. Cendali & Brendan T. Kehoe, *Technology and Entertainment Coverage 2009: Hot Business and Legal Issues in “Technotainment”*, 978 PLI/PAT 93, 107 (2009) (citing Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (2006)). “In essence, domain names are like street addresses for the Internet – They allow an Internet server to find a particular website.” Aura Lichtenberg and Melissa Solomon, *What Social Squatting Means for Trademark Holders: How to Protect Your Brand On Social Networking Sites*, 22 DCBA BRIEF 36, 36-37 (2009). Every domain name has two parts, the top-level domain that follows the dot (such as .com or .org) and the second level domain “which is the name that directly precedes the dot in every web address.” *Id.* at 37. “Most legal issues arise regarding the second-level domain because there cannot be two identical second-level domains under the same top-level domain.” *Id.*

86. *See* Lichtenberg, *supra* note 85, at 37 (explaining reasoning for creating domain name protections).

87. *See id.* (addressing how domain name disputes arise).

88. *See* Zohar Efroni, *The Anticybersquatting Consumer Protection Act and the Uniform Dispute Resolution Policy: New Opportunities for International Forum Shopping?*, 26 COLUM. J.L. & ARTS 335, 337-38 (2003) (discussing different types of cybersquatting and instruments usable by those whose rights are infringed).

“Classic” cybersquatters register domain names based on trademarks and try to sell them to mark owners for profit. By contrast, a second group, “cyberpirates,” incorporate marks in their domain names to attract traffic and divert users from their intended destination, making profits from the inadvertent “hits” on their websites and from advertisements posted on those sites. A third group, “typosquatters,” indulge[s] in the activity of registering domain names that incorporate marks in a few variations (sometimes dozens), including misspelling or incomplete names. . . Finally, there are “pseudo-cybersquatters,” passive registrants, who merely hold domain names without operating websites. They conduct no online activity using the domain names and do not offer them for sale.
Id. at 337.

89. *See id.* at 338 (naming two forums available for cybersquatting claims).

90. *Id.*

in or using a domain name that is identical or confusingly similar to a mark or dilutive of a famous mark (with bad faith intent to profit).⁹¹ The act specifies a non-exhaustive list of factors a court may use to determine whether there is bad-faith intent to profit.⁹² Included in that list is (1) “the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;” (2) “the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name;” and, (3) “the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous. . . .”⁹³

The ACPA also grants courts authority to provide remedies.⁹⁴ These remedies include: “forfeiture, cancellation or transfer of the disputed domain name, as well as either actual damages, or statutory damages of not less than \$1,000 and not greater than \$100,000 per domain name.”⁹⁵ The ACPA allows a suit to proceed “in rem” “against the domain name itself in the district where the domain name was registered” regardless of the identity or location of the registrant.⁹⁶

Relatively new to courts, the ACPA has, thus far, been adopted with a narrow examination for ACPA liability.⁹⁷ Courts have constructed three basic questions to determine liability: “(i) is the mark distinctive or famous; (ii) is the domain name in question identical or confusingly similar to the mark; and (iii) was there a bad faith

91. *Id.* at 346; *see also* Jeffrey D. Neuburger, *New Media, Technology and the Law: A Summary of Key Legal Developments Affecting Technology and Emerging Business Models*, 978 PLI/ PAT 249, 271 (2009) (explaining provisions of ACPA). Under the ACPA, a famous mark can include some personal names. *Id.* at 271.

92. *See* Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)(1)(B) (listing factors courts may use in analysis); *see also* Lee Anne Fennell, *Adjusting Alienability*, 122 HARV. L. REV. 1403, 1415 (2009) (defining cybersquatting and controlling law).

93. 15 U.S.C. § 1125(d)(1)(B).

94. *See* Neuburger, *supra* note 91, at 271 (discussing remedies provided by ACPA).

95. *Id.* at 271.

96. Efroni, *supra* note 88, at 347; *see also* *Mattel, Inc. v. Barbie-Club.com*, 310 F.3d 293, 294 (2d Cir. Nov. 7, 2002) (holding in rem jurisdiction of ACPA to apply only to district in which domain name is registered); *Broadbridge Media LLC v. Hypercd.com*, 106 F. Supp. 2d 505, 510-11 (S.D.N.Y. 2000) (applying ACPA’s in rem provisions to hold jurisdiction over cybersquatting case). This gives the ACPA a further jurisdictional reach than the Lanham Act. *See* Efroni, *supra* note 88, at 347.

97. *See* Efroni, *supra* note 88, at 347 (discussing court analysis and application of ACPA).

intent to profit.”⁹⁸ Finally, trademarks in domain names are used quite often for purposes of criticism and parody.⁹⁹ Courts vary in their decisions on this type of use.¹⁰⁰

2. *Uniform Domain Name Dispute Resolution Policy (adopted by Internet Corporation for Assigned Names and Numbers)*

The Uniform Domain Name Dispute Resolution Policy (UDRP), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN), is an instrument that provides remedy to cybersquatting victims.¹⁰¹ The UDRP is composed of arbitrators who have the power to provide limited relief by either transferring the domain name to the complainant, or cancelling the domain name.¹⁰² UDRP's purpose is to determine:

- (1) if the disputed domain name is identical or confusingly similar to a trademark or service mark in which a complainant has rights;
- (2) if the registrant has no rights or legitimate interest in the domain name; and,
- (3) if the domain name has been registered and is being used in bad faith.¹⁰³

Therefore, a complainant may attempt, and possibly succeed, in recovering multiple names in a single action.¹⁰⁴ Generally, UDRP proceedings resemble civil law proceedings.¹⁰⁵ They also

98. *Id.* See, e.g., *Shields v. Zuccarini*, 254 F.3d 476, 482-86 (3d Cir. 2001) (using three part test as to whether (1) mark was distinctive or famous, (2) domain name was identical or confusingly similar to mark, and (3) there was bad faith intent to profit). For further discussion of case interpretation of ACPA, see *supra* note 91 and accompanying text.

99. See Neuburger, *supra* note 91, at 279 (noting commonness of use of trademarks in domain names for purpose of criticism or parody). Many times these types of sites are called “gripe sites.” *Id.* “Opinions in disputes over these so-called ‘gripe sites’ under trademark law and the ACPA vary in their results, as do rulings under the ICANN UDRP.” *Id.*

100. See *id.* (noting varied court decisions on issues of using trademarks in domain names in spirit of parody or criticism).

101. See *id.* at 269-70 (discussing resolution opportunity through UDRP for victims of cybersquatting).

102. See *id.* at 269 (noting remedies available in UDRP action).

103. *Id.* at 270.

104. See Mairead Moore, *Cybersquatting: Prevention Better Than Cure?*, 17 INT'L J.L. & INFO. TECH 220, 227 (2009) (noting cost effectiveness of UDRP).

105. See Anne H. Hocking, *Basic Principles of Trademark Law*, 973 PLI/PAT 83, 117 (2009) (“There is no discovery, no personal appearances or telephone conferences with the adjudicator; everything is done on paper.”); see also ICANN, Rules for Uniform Domain Name Dispute Resolution Policy (Oct. 24, 1999), available at <http://www.icann.org/en/udrp/udrp-rules-24oct99.htm> [hereinafter “Rules for

move quite quickly, requiring the adjudicator to come to a decision within three weeks.¹⁰⁶ In cases where the complainant prevails, the remedy will “take place 10 days after the decision is issued unless the panel is informed by the defendant that they are initiating court proceedings [via ACPA] on the matter.”¹⁰⁷ Conversely, because there is no *res judicata*, in cases where the complainant does not prevail, a plaintiff can re-file repeatedly with any “domain name dispute provider. . . until the desired result is reached.”¹⁰⁸

3. *ACPA v. UDRP; Which One Should I Use?*

Complainants may file suit under either the ACPA or through UDRP.¹⁰⁹ Thus, a complainant should determine the best forum to fit a case by weighing the pros and cons of each forum.¹¹⁰ Once cybersquatting is apparent, both provide helpful remedies.¹¹¹

The UDRP may prove to be a better forum not only because of its efficiency and timeliness, but also because of its “user-friendly” quality.¹¹² Conversely, the “ACPA is not ideal for solving political-cybersquatting problems because: (1) litigation is too costly and slow for most candidates; (2) non-commercial cybersquatters may not have the requisite ‘bad faith intent to profit;’ and (3) jurisdictional issues may prevent American courts from reaching foreign cybersquatters.”¹¹³ Further, the UDRP has a “user-friendly” procedure that is “both a quick method of resolving disputes quickly and

UDRP”] (enumerating rules established by ICANN under UDRP to file proceedings against alleged infringers).

106. See Hocking, *supra* note 105, at 117 (explaining UDRP proceedings).

107. Moore, *supra* note 104, at 226-27.

108. Hocking, *supra* note 105, at 117 (“[A]n aggrieved domain name plaintiff can simply re-file with the same or different domain name dispute provider, such as the World Intellectual Property Organization or National Arbitration Forum.”). See also ICANN, Approved Providers for Uniform Domain-Name Dispute-Resolution Policy, <http://www.icann.org/en/dndr/udrp/approved-providers.htm> (last visited Sept. 29, 2009) [hereinafter “Approved Providers for UDRP”] (providing list of approved providers under whom to file for UDRP arbitration).

109. See Lichtenberg, *supra* note 85, at 41-42 (noting complainant’s need to choose between forums).

110. See *id.* (mentioning when ACPA works best for complainant).

111. See *id.* at 41 (stating both ACPA and UDRP provide helpful remedies for cybersquatting cases).

112. See Matthew T. Sanderson, *Candidates, Squatters, and Grippers: A Primer on Political Cybersquatting and a Proposal for Reform*, 8 ELECTION L.J. 3, 14 (2009) (discussing situations for which filing suit under ACPA may not be ideal and for which UDRP provides better remedies); see also Moore, *supra* 104, at 227 (noting positive qualities of using UDRP arbitration for cybersquatting cases). “In terms of time-cases, it is possible to finish a regular UDRP case between 47 and 57 days from the submission of the complaint. The UDRP is also extremely cost effective.” *Id.*

113. Sanderson, *supra* note 112, at 14.

also a relatively cheap option.”¹¹⁴ Finally, in cases where a complainant “can easily prove the registrant’s bad faith registration of a domain name, then it may be preferable to initiate an ICANN proceeding under the UDRP.”¹¹⁵

Conversely, filing federal suits under the ACPA may prove beneficial in complicated cases.¹¹⁶ “When an issue of contract, free speech or trademark infringement is involved, in addition to an issue of bad faith registration and use, the better course of action is to file a federal lawsuit under the ACPA.”¹¹⁷ Also, if a complainant desires monetary damages, *as well as* equitable relief, the best choice is to file a lawsuit under the provisions of the ACPA.¹¹⁸

F. Social Networks’ Metamorphosis With the Law

The top social networks adapted to Congressional legislation to take advantage of liability immunity.¹¹⁹ The two most popular social networks, Facebook and MySpace, have gone through a series of changes to avoid liability.¹²⁰ Nevertheless, both networks have found themselves at the center of several lawsuits questioning whether their policies are enough to remove them from liability.¹²¹ MySpace and Facebook are sites that connect their users by “integrating personal profiles, photos, videos, mobile, messaging, [and] games.”¹²²

114. Moore, *supra* note 104, at 227.

115. Lichtenberg, *supra* note 85, at 42.

116. *See id.* at 41-42 (“[R]ights holders might want to consider bringing claims under the ACPA when a case requires discovery of complicated facts . . .”).

117. Deborah A. Wilcox, *What Trademark Owners Need to Know About Domain Names*, 962 PLI/PAT 769, 776 (2009).

118. *Compare* Neuburger, *supra* note 91, at 271 (discussing remedies allowed under ACPA) *with* Neuburger, *supra* note 91, at 270 (discussing remedies allowed under UDRP).

119. For full discussion on social networks that have adapted to the immunity of the CDA and DMCA through the drafting of their terms of service, see *infra* text and accompanying notes 123-129.

120. *See* Kazeniak, *supra* note 11 (portraying Facebook and MySpace as holding top two positions as most popular site measured by visits per month by users); see also *infra* text accompanying notes 123-129. MySpace and Facebook are sites that connect their users by “integrating personal profiles, photos, videos, mobile, messaging, [and] games.” *MySpace Press Room: About MySpace*, MYSPACE.COM, <http://www.myspace.com/pressroom?url=/> (last visited Sept. 23, 2009) [hereinafter MySpace Press Release]; see also Press Room: Facebook Factsheet, FACEBOOK.COM, <http://www.facebook.com/press/info.php?factsheet> (last visited Sept. 23, 2009) [hereinafter Facebook/Factsheet] (portraying facts about Facebook).

121. For full discussion of lawsuits faced by MySpace and Facebook, see *infra* text and accompanying notes 123-142.

122. MySpace Press Release, *supra* note 120 (portraying facts about MySpace); see also Facebook/Factsheet, *supra* note 120 (portraying facts about Facebook).

1. *The CDA/DMCA and the Social Network*

As previously discussed, the CDA protects social networks from most state action liability, except some of those pertaining to intellectual property.¹²³ Furthermore, the DMCA provides additional protections to social networks qualifying for safe harbor in cases involving intellectual property infringement.¹²⁴ In an effort to protect themselves under the CDA and DMCA safe harbors, both Facebook and MySpace include language in their terms of service, which avails themselves to the protections offered by both legislations.¹²⁵ First, both sites reserve the right to remove any materials they see fit for any or no reason.¹²⁶ Second, both sites reserve the right to terminate users for any or no reason, specifically in instances of repeat offenses.¹²⁷ Finally, neither site works to “interfere with standard technical measures” and have availed themselves to specified United States courts.¹²⁸ In this sense, both social networks have attempted to maneuver themselves under the shelter of the law.¹²⁹

123. For full discussion on the CDA, see *supra* text and accompanying notes 46-57.

124. For full discussion on the DMCA and safe harbor requirements, see *supra* text and accompanying notes 58-66.

125. See *Statement of Rights and Responsibilities*, FACEBOOK.COM, Dec. 21, 2009, <http://www.facebook.com/terms.php?ref=pf> [hereinafter Facebook TOS] (providing terms of use that include language reserving rights to remove any content posted by users, and expressing disapproval of posted materials that infringe others' rights); see also MySpace.com Terms of User Agreement, MYSPACE.COM, Jun. 25, 2009, <http://www.myspace.com/index.cfm?fuseaction=misc.terms> [hereinafter MySpace TOS] (detailing prohibited materials that may not be posted, as well as reserving right to remove information for any or no reason).

126. Compare Facebook TOS, *supra* note 125 (enumerating terms of service for Facebook users and rights reserved by network providers) with MySpace TOS, *supra* note 125 (addressing terms of service for MySpace users and rights reserved by network provider).

127. Compare Facebook TOS, *supra* note 125 (enumerating terms of service for Facebook users and rights reserved by network providers) with MySpace TOS, *supra* note 125 (addressing terms of service for MySpace users and rights reserved by network provider).

128. DMCA, *supra* note 31, § 517(i)(B); see also MySpace TOS, *supra* note 125 (“The Agreement shall be governed by . . . the laws of the State of New York, without regard to its conflict of law provisions. You and MySpace agree to submit to the exclusive jurisdiction of the courts located within the State of New York to resolve any dispute arising out of the Agreement or the MySpace Services.”); Facebook TOS, *supra* note 125 (“You will resolve any claim, cause of action or dispute (“claim”) you have with us arising out of or relating to this Statement or Facebook exclusively in a state or federal court located in Santa Clara County.”).

129. Compare Facebook TOS, *supra* note 125 (enumerating terms of service for Facebook users and rights reserved by network providers) with MySpace TOS, *supra* note 125 (addressing terms of service for MySpace users and rights reserved by network provider).

2. *Cybersquatting and the Social Network*

Most cybersquatting cases pertain to top-level domains (i.e., “.com,” “.gov” or “.edu”) preceded by second level domain terms.¹³⁰ When Facebook released an option to its users to register usernames, the social network had a brush with cybersquatting-like issues.¹³¹ The issue involving Facebook is unique, because the usernames are contained in the post domain path level (after the “.com” in a URL).¹³² Therefore, the mark allegedly used in infringement is not within the “domain name” as defined by courts under the ACPA.¹³³ Although the username position, after the “.com,” de-classifies the trademarks from being within a “domain name” as defined by the courts under the ACPA and UDRP, the issues involved are remarkably similar.¹³⁴

Facebook anticipated a problem of bad faith registration, and created a policy stating “the chosen username should be as close as possible to the user’s true name, and ‘must adhere to Facebook’s Statement of Rights and Responsibilities.’ [Further,] [b]efore launch of the registration, Facebook allowed users who own registered trademarks to register them with Facebook” prior to the remainder of the Facebook user population, “so that their trademarks would not be included in the vanity URLs open for registration.”¹³⁵ If a registered trademark owner did not register in time, Facebook

130. See Peter T. Wakiyama & Odia Kagan, *Facebook Vanity URLs May Hurt More Than Just One’s Pride*, 21 NO. 9 INTELL. PROP. & TECH. L.J. 7, 8 (2009) (citation omitted) (discussing typical cybersquatting cases). Lawsuits for trademark infringement generally arise when the second level domain terms contain a protected mark without the holder’s consent or knowledge, and the use of the mark is in bad-faith. See *id.* (presenting typical elements of trademark infringement lawsuits).

131. See *id.* (discussing claims against Facebook after issuing user names). For further discussion on post-domain paths, see *infra* text and accompanying notes 138-142. The user names can only be used once, and come after the “.com” in the Facebook address (i.e. www.facebook.com/jdoe) and have been donned as “vanity URLs”. Wakiyama, *supra* note 130, at 7 (“On June 13, 2009, Facebook vanity URLs opened for registration by its users. Instead of www.facebook.com/id=591932074, a user’s page would now be located at www.facebook.com/johndoe, allowing the user to be easily found by entering his or her name into the URL in the browser.”). “Examples of the new pages can be seen at www.facebook.com/cocacola, www.facebook.com/gap, and www.facebook.com/mcdonalds. Within the first three minutes of the availability of the Facebook vanity URLs, 200,000 URLs were registered; within 15 minutes, more than half a million had registered.” *Id.*

132. See *id.* (discussing position of usernames in post domain path).

133. See *id.* at 8 (describing court definition of domain names). Note that the ACPA does not actually provide a definition for a domain name within its text. ACPA, *supra* note 31.

134. See Wakiyama, *supra* note 130, at 8 (describing post-domain paths and similarity to other cybersquatting issues).

135. *Id.*

has incorporated a remedy within its terms of service (TOS).¹³⁶ Today, it is unclear as to whether a trademark holder would prevail in either an ACPA or UDRP action citing cybersquatting as a cause of action against a social network for a trademark included in a post-domain path.¹³⁷

Before the boom of social networks, one particular case may shed some light on a court's outcome today, if followed.¹³⁸ In *Interactive Products Corp. v. a2z Mobile Office Solutions, Inc.*, the Sixth Circuit determined that a similar or same "post-domain path" of a URL does not rise to the level of causing a "likelihood of confusion," and therefore, is not trademark infringement.¹³⁹ The court based its holding on the rationale that the "post-domain path of a URL. . . does not typically signify source [of goods or services]. The post-domain path merely shows how the website's data is organized within the host computer's files."¹⁴⁰ With new developments in the use of post-domain name paths, especially in cases of social networks like Facebook and Twitter, courts may take a different approach to the situation and find added protections necessary.¹⁴¹ In

136. *See id.* ("The first stop in an aggrieved trademark owner's road to recovery for the misappropriation of his or her trademark would be the Facebook terms of service (TOS), which govern users' activities on the Facebook site."). The TOS states, "[i]f you select a username for your account we reserve the right to remove or reclaim it if we believe appropriate (such as when a trademark owner complains about a username that does not closely relate to a user's actual name)." Facebook TOS, *supra* note 125.

137. *See* Wakiyama, *supra* note 130, at 7 (posing questions about viability of case for cybersquatting under ACPA or UDRP).

138. *See* Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 696-98 (6th Cir. 2003) [hereinafter *Interactive*] (holding that post-domain paths do not constitute same thing as domain names as defined by ACPA).

139. *See id.* at 698 (holding that typically similar post-domain paths will not rise to level of trademark infringement).

140. *Id.* at 696-97. Notably, the plaintiff in this case "did not present any evidence that the presence of its trademark in the post-domain path caused actual confusion or was likely to cause consumer confusion." Enrico Schaefer, *The ACPA: Trademark Violations in Domains*, May 17, 2007, <http://www.articlesbase.com/intellectual-property-articles/the-acpa-trademark-violations-in-domains-149148.html>. Arguably, presenting this type of evidence may have caused the court to hold differently. *See id.* ("If such evidence existed and was presented, the outcome could have been different.").

141. *See* Cendali, *supra* note 85, at 113 ("[T]he new significance of post-domain name paths may cause courts to see the situation differently."). Notably, a court may determine that the post-domain paths now signify a source when preceded by a social network second legal domain. *See id.* (discussing ramifications of new level of importance placed on post-domain name paths). The username within a post-domain path could be shown to signal the owner of an accounts page, therefore leading an Internet user to have a higher likelihood of confusion. *Id.*; *see also* Schaefer, *supra* note 140 (stating that stronger showing of likelihood of confusion may have caused court to have different conclusion).

any event, some argue the best protection for a trademark owner is to remain pro-active by checking trademark use on the Internet, and personally registering on social networks to stop the problem before it starts.¹⁴²

III. ANALYSIS

Despite Tony La Russa dropping his suit, he raised several interesting and creative claims against Twitter.¹⁴³ Although few will argue that La Russa had a strong case, the issues presented have the potential to become a pressing concern in the near future.¹⁴⁴ Further, Twitter's attempt to modify its self-regulation policy may help it to dodge a similar lawsuit, or at least give it the upper hand.¹⁴⁵

A. Tweet, a Squawk, or a Whiff (La Russa v. Twitter, Inc.)

In the first ever lawsuit against Twitter, La Russa raised a variety of claims.¹⁴⁶ His claims contained both tortuous and intellectual property claims.¹⁴⁷ La Russa's complaint contained eight causes of action, including: (1) Trademark Infringement; (2) False Designation of Origin; (3) Trademark Dilution; (4) Cybersquatting; (5) Misappropriation of Name; (6) Misappropriation of Likeness; (7) Invasion of Privacy; and, (8) Intentional Misrepresentation.¹⁴⁸

1. *Trick or Tweet (Claims for Misappropriation of Name and Likeness, Invasion of Privacy, and Intentional Misrepresentation)*

First, La Russa raised a tortuous claim for misappropriation of name or likeness.¹⁴⁹ In most states, a plaintiff must establish three

142. See Moore, *supra* note 104, at 228 (“[I]t has been suggested by many, that the solution lies not in [the] reactive stage, but should be pro-active in the sense that it can be prevented at the earlier registration stage.”). There are some sites that allow individuals to check their trademarks at several social networking sites in one fell swoop. See, e.g., Namechk.com, Check Username Availability at Multiple Social Networking Sites, <http://namechk.com/> (last visited Oct. 18, 2009) (“Check to see if your desired *username* or *vanity URL* is still available at dozens of popular Social Networking and Social Bookmarking websites.”).

143. See McGeveran, *supra* note 16 (discussing eccentricity of La Russa's claim against Twitter).

144. See *id.* (noting weaknesses of La Russa's case against Twitter).

145. See *id.* (commenting on Twitter's attempt to sell verified accounts to celebrities).

146. See Complaint, *supra* note 6 (listing La Russa's claims in lawsuit); see also Elinson, *supra* note 14 (“La Russa's suit is the first of its kind against Twitter.”).

147. See Complaint, *supra* note 6 (listing La Russa's claims against Twitter).

148. See *id.* (enumerating La Russa's claims in lawsuit).

149. See *id.* (listing La Russa's claims for misappropriation of name or likeness).

elements to prevail in this cause of action.¹⁵⁰ The elements are (a) use of a protected attribute, (b) for an exploitive purpose, and (c) without consent.¹⁵¹ To establish the use of a protected attribute, a plaintiff may show that the offending party used “an aspect of his or her identity that is protected by the law. This ordinarily means a plaintiff’s name or likeness, but the law protects certain other personal attributes as well.”¹⁵² Next, to establish that the defendant unlawfully used a protected mark, most states require the plaintiff to show that the defendant used the attribute for the defendant’s own benefit.¹⁵³ Furthermore, “[c]onsent is a complete defense to a legal claim for misappropriation of name or likeness.”¹⁵⁴ In his case, La Russa claimed that by using his name and image on the false account page, Twitter misappropriated his name and likeness, as well as projected the illusion of his endorsement.¹⁵⁵

150. See Citizen Media Law Project, Using the Name or Likeness of Another, <http://www.citmedialaw.org/legal-guide/using-name-or-likeness-another> (last visited Oct. 19, 2009) (discussing three factors necessary for plaintiff to show when raising claim for misappropriation of name or likeness).

151. See *id.* (noting that name used does not need to be complainant’s “full or formal name, just something that is sufficient to identify” complainant). Further, “[l]ikeness” refers to a visual image” of the complainant. *Id.* This may take any of a variety of forms, which do not need to “precisely reproduce the [complainant’s] appearance . . . so long as it is enough to evoke the [complainant’s] identity in the eyes of the public.” *Id.*

152. *Id.*; see, e.g., *Carson v. Here’s Jonny Portable Toilets, Inc.* 698 F.2d 831 (6th Cir. 1983) (holding that use of “Here’s Johnny” slogan within brand name was sufficient to suggest Johnny Carson’s identity); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (holding defendant liable for using photograph of plaintiff’s race car in commercial); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992) (holding defendant liable for using robot resembling Vanna White in television commercial).

153. See Citizen Media Law Project, *supra* note 150 (discussing that individual can be held liable for using plaintiff’s name or likeness for own benefit). A defendant may also be found liable “for some non-commercial uses of someone’s name or likeness if [the defendant] exploit[s] the plaintiff’s identity for [the defendant’s] own benefit.” *Id.*; see, e.g., *Faegre & Benson, LLP v. Purdy*, 367 F. Supp. 2d 1238 (D. Minn. 2005) (holding anti-abortionist activists liable for registering domain names containing names or nicknames of rivals because registration was for own benefit); *Felsher v. Univ. of Evansville*, 755 N.E.2d 589, 600 (Ind. 2001) (holding professor liable when he used colleagues’ names in non-commercial websites and email accounts to elicit viewers back to own website and it was therefore misappropriation which “enabled him to pursue a personal vendetta”); *McMann v. Doe*, 460 F. Supp. 2d 259 (D. Mass. 2006) (holding defendant *not* liable for posting photograph of real estate on “gripe site”). For a further definition of “gripe sites,” see *supra* note 99.

154. Citizen Media Law Project, *supra* note 150.

155. See Complaint, *supra* note 6 (listing La Russa’s allegations against Twitter in misappropriation claim).

Second, La Russa raised an invasion of privacy claim.¹⁵⁶ His complaint contained language set out in the California Civil Code generally used at common law for right of publicity claims.¹⁵⁷ Section 3344 of the California Civil Code provides that “anyone who knowingly uses another’s name, signature, photograph or likeness, in any manner, for the purpose of advertising or selling or soliciting without such person’s prior consent shall be liable for any damages sustained.”¹⁵⁸ Accordingly, La Russa argued that Twitter “ha[d] made an unauthorized use of his name, signature, photograph and likeness, in a manner to which he has not consented” and as a result, La Russa “ha[d] suffered emotional distress, damage to his reputation and general damages in the sum to be shown according to proof.”¹⁵⁹

Third, La Russa claimed intentional misrepresentation.¹⁶⁰ This type of claim is “‘usually a fact-intensive inquiry and requires that the plaintiff allege reliance upon the misrepresentation.’”¹⁶¹ In his complaint, La Russa alleged that, by publishing “Tony La Russa is using Twitter,” the representation was false and was made available “to all members of the public over the internet.”¹⁶² La Russa, therefore, concluded that he suffered “significant emotional distress and damage to his reputation.”¹⁶³

Although a complaint is not complete without raising every element, current law has well established that Internet service providers, especially those in Twitter’s position as an intermediary, have

156. *See id.* (listing invasion of privacy as one claim against Twitter).

157. *See* Russell J. Frackman & Tammy C. Bloomfield, *The Right of Publicity: Going to the Dogs?*, UCLA ONLINE INST. FOR CYBERSPACE LAW AND POL’Y (Sept. 1996), available at <http://www.gseis.ucla.edu/iclp/rftb.html> (“In California, the right of publicity is protected both by statute for ‘name, voice, signature, photograph or likeness’ (Civil Code § 3344) and, more generally, at common law.”).

158. Complaint, *supra* note 6; *see* CAL. CIV. CODE. § 3344 (West 2009). Also, note that in *Laws v. Sony Music Entm’t, Inc.*, Section 3344 of the California Civil Code is limited on preemption grounds. 448 F.3d 1134 (9th Cir. 2006). In this case, the court found that the plaintiff’s claim was too similar to a copyright claim, covered by federal law. *See generally id.* Therefore, the court determined that federal law, the Copyright Act, preempted the plaintiff’s state claim under Section 3344. *See id.* at 1141 (“[F]ederal copyright law preempts a claim alleging misappropriation of one’s voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium.”).

159. Complaint, *supra* note 6.

160. *See id.* (listing intentional misrepresentation as claim against Twitter).

161. Matthew Walker, *Low-Fat Foods or Big Fat Lies?: The Role of Deceptive Marketing in Obesity Lawsuits*, 22 GA. ST. U.L. REV. 689, 696 (2006) (citation omitted).

162. Complaint, *supra* note 6.

163. *Id.*

been granted wide latitude to qualify for immunity.¹⁶⁴ Twitter's policies and interaction with the site place it within the safe harbors provided by Section 230 of the CDA.¹⁶⁵ La Russa's claims for invasion of privacy, however, may have been meant to be right of publicity claims under Section 3344 of the California Civil Code.¹⁶⁶ If La Russa's invasion of privacy claim is construed as a right to publicity claim, courts have held that social networks are not afforded Section 230 immunities.¹⁶⁷ In a right of publicity claim, the plaintiff must show that the network provider unlawfully used a person's name or likeness for commercial benefit.¹⁶⁸ Therefore, assuming that his claim is construed in this nature by the court, La Russa's

164. See Venkat Balasubramani, *Tony La Russa's Legal Claims Against Twitter Look Tenuous*, CIRCLEID, June 09, 2009, http://www.circleid.com/posts/20090609_tony_la_russas_against_twitter_tenuous (discussing weaknesses and points of interest raised by La Russa's suit against Twitter).

165. See *id.* (addressing broad grant of immunity to internet service providers acting as intermediaries). For full discussion on immunity granted to service providers by Congressional legislations, see *supra* text and accompanying notes 46-57.

166. For full discussion on California common law use of Section 3344, see *supra* text and accompanying note 157-158. Further, there are sections in the California Civil Code illustrating physical and constructive invasion of privacy provisions, not cited in La Russa's complaint. See Cal. Civ. Code §§ 1708.8(a)-(b) (Deering 2009). The constructive invasion of privacy provision follows:

A person is liable for constructive invasion of privacy when the defendant attempts to capture, in a manner that is offensive to a reasonable person, any type of visual image, sound recording, or other physical impression of the plaintiff engaging in a personal or familial activity under circumstances in which the plaintiff had a reasonable expectation of privacy, through the use of a visual or auditory enhancing device, regardless of whether there is a physical trespass, if this image, sound recording, or other physical impression could not have been achieved without a trespass unless the visual or auditory enhancing device was used.

Id. § 1708.8(b).

167. See Citizen Media Law Project, *supra* note 150 (discussing proceedings in *Doe v. Friendfinder Network, Inc.*, 540 F. Supp. 2d 288 (D.N.H. 2008)). In *Doe v. Friendfinder Network, Inc.*, the court "held that CDA [Section] 230, which immunizes website operators from many state law legal claims based on user-generated content, does not apply to right of publicity claims. Therefore, [Plaintiff's] claim against the social networking site could go forward, despite the fact that a third-party created the profile." *Id.* (citation omitted). Further, the "[r]ight of publicity protection may cover the use of any personal element that allows the public to identify the individual." Coats, *supra* note 5, at 275. The extent that a court will allow protection to individuals, however, varies from state to state. See *id.* (discussing varying treatment of publicity claims).

168. See Citizen Media Law Project, *supra* note 150 (discussing lack of protection to social networks when faced with right of publicity claims). "A plaintiff that sues [another] for interfering with [the right of publicity] generally must show that [the defendant] used [the plaintiff's] name or likeness for a commercial purpose." *Id.* (emphasis omitted). An individual "can be liable even without creating a false sense that the person in question endorses [that individual's] product or service; the key is that [that individual is] exploiting the plaintiff's identity to drive traffic or obtain some other commercial benefit." *Id.*

case would proceed.¹⁶⁹ Even so, the standard is convoluted and a remedy may remain illusory on these types of claims.¹⁷⁰ Several cases have required that the plaintiff must suffer an economic harm in addition to a showing of the defendant's commercial benefit.¹⁷¹ Nevertheless, once clear of the immunity hurdle, it is uncertain whether a court will find in La Russa's favor, or if his claim will be caught on the warning track.¹⁷²

2. *Can't Tweet This (Claims for Trademark Infringement/Dilution)*

Trademark infringement is "the unauthorized use of a trademark – or of a confusingly similar name, word, symbol, or any combination of these – in connection with the same or related goods or services and in a manner that is likely to cause confusion, deception, or mistake about the source of the goods or services."¹⁷³ In his complaint, La Russa states his name is the infringed trademark.¹⁷⁴ Further, he claims that the unauthorized use of his name by a Twitter member constitutes an infringement of his mark.¹⁷⁵ The complaint also spells out that Twitter's "use of [La Russa's] mark both in the Site's domain name and on the Site itself is misleading and likely to confuse users by leading them to believe that this Site is endorsed and authored by [] La Russa."¹⁷⁶

169. *But cf. id.* (discussing court holdings preventing social networks from seeking cover under Section 230 immunities).

170. *See Coats, supra* note 5, at 288-89 (discussing case history that also required economic harm to plaintiff alleging harm under right of publicity claims).

171. *See id.* (addressing cases assessing right of publicity claims). "[S]ome commentators have argued that the right of publicity restricts cultural expression. Courts deal with this tension by balancing a person's right to earn a living from his fame against the consequences of restricting another's freedom of expression." *Id.* at 288.; *see also, Zacchini v. Scripps – Howard Broad., Co.*, 433 U.S. 562, 575-76 (1977) (discussing that television station violated Zacchini's right of publicity by broadcasting Zacchini's entire human cannonball act, and therefore was not extended First Amendment protections); *C.B.C. Distribution and Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 443 F. Supp. 2d 1077, 1097 (E.D. Mo. 2006) (reasoning that using player plaintiff's statistics on its fantasy baseball website did not interfere with player plaintiff's ability to financially benefit from playing baseball, therefore protecting defendant under First Amendment expression freedoms).

172. *See McGeeveran, supra* note 16 (noting weakness of La Russa's case).

173. BLACK'S LAW DICTIONARY 797 (8th ed. 2004).

174. *See Complaint, supra* note 6 (listing La Russa's various claims against Twitter).

175. *See id.* (stating La Russa's claims against Twitter). The complaint states that "[Twitter, Inc.] owns the registered domain name twitter.com and pursuant thereto, twitter.com/TonyLaRussa. The Site contains an unauthorized photograph of Plaintiff and written statements impliedly written by [La Russa] himself, when in fact they are not." *Id.*

176. *Id.*

Although “[d]ozens of cases over the last decade or so have addressed the question of whether ‘using’ a third party trademark on a website constitutes trademark infringement,” La Russa’s claim against Twitter is one of the few against a social networking site for content posted by a third party.¹⁷⁷ Remarkably, La Russa attempts to rework tort rights into an area not protected by the CDA and potentially not covered under the safe harbor of the DMCA.¹⁷⁸ If La Russa had prevailed, this would have created the “possibility of a loophole for celebrities who can recast . . . claims under trademark law . . . [and] . . . [this may create a] double standard: celebrities maligned by anonymous online impostors could plead around Section 230 [of the CDA] by claiming trademark . . . rights in their name, while many ordinary people victimized . . . would have their claims blocked.”¹⁷⁹ This brings the argument full circle as to whether Internet media should belong to the same rules as traditional mediums such as newspapers, and television and radio broadcasts.¹⁸⁰ Looking back at original defamation in media cases, such as *New York Times Co. v. Sullivan*, the Supreme Court held for the requirement that public officials (and celebrities) prove a higher standard of defamation, libel, and slander than required by a private individual.¹⁸¹ The rationale is that public officials are more capable of handling and possibly counteracting this type of harm.¹⁸² If celebrities, however, continue to hurdle the CDA immunities by claiming trademark infringement, then it is the private individuals who will be left with the higher hurdle: a contradictory consequence from the original rationale of the Supreme Court.¹⁸³

Some dispute exists, however, as to whether La Russa properly classified his name as a trademark.¹⁸⁴ First, “surnames (names of

177. See Hocking, *supra* note 53, at 197-98 (citing treatment of third party trademark infringement claims in past cases).

178. See *id.* at 196-98 (discussing scope of CDA protection and DMCA safe harbor).

179. McGeeveran, *supra* note 16.

180. See *id.* (noting differences between traditional forms of media and Internet media).

181. See *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (requiring higher standard of proof of actual malice for public officials than required for private individuals).

182. See *id.* at 283-84 (discussing rationale for higher standard of proof for celebrities and public officials).

183. See McGeeveran, *supra* note 16 (discussing possible consequence if celebrities prevail when restructuring claims from tort claims to trademark infringement claims).

184. See Balasubramani, *supra* note 164 (addressing holes in La Russa’s suit against Twitter).

people) typically are not entitled to trademark protection.”¹⁸⁵ Second, from the complaint, La Russa does not assert that he has registered his name as an official trademark.¹⁸⁶ Finally, putting aside the issue as to whether La Russa’s name is a protected mark, trademark infringement requires not only the mark’s use in commerce, but also likelihood of confusion regarding its use.¹⁸⁷ Arguably, it is difficult to speculate that because the site page contained the phrase “Hey There! Tony La Russa is using Twitter,” Twitter experienced a commercial benefit.¹⁸⁸ This is particularly so, considering the page only had four followers.¹⁸⁹ Because the page “hinted” that the postings were in the spirit of parody, establishing likelihood of confusion is also difficult.¹⁹⁰ Additionally, a population of four followers may not be a large enough to show substantial harm even if it can be shown that the page had likelihood to cause confusion.¹⁹¹ Therefore, even if La Russa’s attorney could convince the court that the use of Tony La Russa’s trademarked name was used in commerce, La Russa still needs to produce a curve ball to strike out Twitter’s First Amendment Freedom of Speech rights to parody.¹⁹²

Next, La Russa not only alleges trademark infringement, but also trademark dilution.¹⁹³ Dilution is “the act or an instance of

185. *Id.*

186. *See id.* (noting lack of discovery because La Russa dismissed claim at early stage). The United States Patent and Trademark Office only has one mark for “Tony La Russa Baseball” and this mark has since been marked dead as of March 26, 2005. *See* Trademark Electronic Search System, <http://tess2.uspto.gov> (follow “New User Form Search” hyperlink; then search “La Russa”) (last visited Mar. 11, 2010) (testing trademark validity). Further, the registering party was not Tony La Russa, but Stormfront Studios, Inc. *See id.* (confirming source of trademark).

187. *See* Balasubramani, *supra* note 164 (addressing necessary showing by La Russa to win suit if continued).

188. *See id.* (stating difficulties La Russa’s complaint contained in making claims of trademark infringement or dilution, and that postings provided Twitter with commercial benefit).

189. *See id.* (discussing weakness in La Russa’s claim); *see also* Complaint, *supra* note 6 (listing La Russa’s claims against Twitter).

190. *See* McGeeveran, *supra* note 16 (“[P]roving confusion and harm will be very difficult, since (1) the account only had four followers; (2) it included a notation in the user’s profile section, “Bio Parodies are fun for everyone.”).

191. *See id.* (discussing La Russa’s potential difficulties establishing likelihood of confusion).

192. *See id.* (“[I]t’s not clear a statement (even a false one) that LaRussa used the service can fairly be called an endorsement of the service.”); *see also* Kevin Fayle, Understanding the Legal Issues for Social Networking Sites and Their Users <http://technology.findlaw.com/articles/00006/010966.html> (“The First Amendment and state constitutional free-speech provisions often come into play in these types of . . . suits.”).

193. *See* Complaint, *supra* note 6 (listing La Russa’s complaints against Twitter).

diminishing a thing's strength or lessening its value, and in this case, the thing is a trademark."¹⁹⁴ La Russa makes this claim because Twitter allegedly used La Russa's "famous mark" after La Russa had already become famous, which "creates the likelihood of dilution of the mark's distinctive value by diminishing the capacity of the mark to identify and distinguish [La Russa's] goods and services."¹⁹⁵ Although "trademark dilution does not require confusion or monetary harm . . . La Russa pleaded under federal dilution law, which allows only injunctive relief – now moot since the profile is gone – and completely exempts 'noncommercial use' of a trademark."¹⁹⁶ Therefore, the dilution claim inevitably was a swing and a miss.¹⁹⁷

3. *Who's Tweet is it Anyway? (Claim for False Designation of Origin)*

False Designation of Origin is protected under Title 15, Section 1125(a) of the Lanham Act, which also covers trademark infringements.¹⁹⁸ Under this provision, La Russa alleges that, "[a]s a direct and proximate result of [Twitter's] actions . . . [La Russa] has suffered significant emotional distress, damage to his reputation, and damages to the goodwill of his mark."¹⁹⁹ Again, La Russa's case is not strong, and he will run into many of the same issues as were addressed above in his tort claims.²⁰⁰ Admittedly, La Russa will have a difficult time arguing that his claims trump First Amendment rights to comment on trademarks in the spirit of parody or criticism.²⁰¹

194. BLACK'S LAW DICTIONARY 489 (8th ed. 2004).

195. Complaint, *supra* note 6 (stating La Russa's basis for claims against Twitter).

196. McGeeveran, *supra* note 16.

197. *See id.* (noting that once Twitter removed fake page, claim became moot issue).

198. *See* ACPA, *supra* note 31 (addressing claims under false designation of origin). The ACPA further states that:

Any person who, on or in connection with any goods or services, or any container for goods, uses . . . any false designation of origin . . . which – is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

199. Complaint, *supra* note 6.

200. *See* Balasubramani, *supra* note 164 (noting weakness of La Russa's case against Twitter and improbability of success on his claims of tortious nature, even when covered under trademark law).

201. *See id.* ("[T]he account obviously stated that it was a parody account, so La Russa doesn't look reasonable arguing that people were really fooled into thinking he endorsed it.").

4. *Tweet-napped (Claim of Cybersquatting)*

As noted above, cybersquatting is “the act of reserving a domain name on the Internet . . . and then seeking to profit by selling or licensing the name to the company that has an interest in being identified with it.”²⁰² La Russa has alleged in his claim of cybersquatting that Twitter’s actions, “constitute a bad faith intent to profit from and injure [La Russa’s] mark, [are] intended to increase traffic to [Twitter’s] site, or were done with knowledge that injury to [La Russa’s] mark was substantially certain to occur.”²⁰³ Because La Russa brought his suit in the United States court system, he is relying on the ACPA, and not UDRP rules.²⁰⁴ As discussed earlier, few cases have determined whether the “post-domain” term (or mark) used is covered by the ACPA.²⁰⁵ Therefore, based on past case law, predating the social network boom, La Russa has a difficult, though not insurmountable, argument to make.²⁰⁶ Further, even if a court considers the use of a trademark in a post-domain path as possible infringement, La Russa’s case to prove likelihood of confusion, as stated above, is still lacking.²⁰⁷ Establishing the necessary elements for La Russa’s claims will be difficult because:

(1) The account only had four followers; (2) it included a notation in the user’s profile section, ‘Bio Parodies are fun for everyone;’ [and] (3) it’s not clear a statement (even a false one) that La Russa used the service can fairly be called an endorsement of the service.²⁰⁸

Perhaps with a different set of facts, a court would be willing to address the issue in a different light.²⁰⁹

202. BLACK’S LAW DICTIONARY 415 (8th ed. 2004).

203. Complaint, *supra* note 6.

204. See Balasubramani, *supra* note 164 (“La Russa’s cybersquatting claims are based in part on a federal statute, commonly known as the ACPA.”).

205. For full discussion on known case analysis of post-domain paths, see *supra* notes 138-42 and accompanying text.

206. See generally Cendali & Kehoe, *supra* note 85, at 113 (remarking on how new popularity of “vanity URLs” may lead to case law directly readdressing issues of social networks’ use and similar bad faith uses of trademarks as seen in typical ACPA and UDRP cybersquatting cases).

207. See McGeeveran, *supra* note 16 (“In this particular case, proving confusion and harm will be very difficult.”).

208. *Id.*

209. See Schaefer, *supra* note 140 (“Each ACPA turns on the particular facts presented.”).

B. Twitter's Reply

Like other social networks, Twitter has an in depth trademark policy, and following La Russa's suit, the site launched an additional protection option for trademark holders.²¹⁰ First, Twitter offers a general protection to intellectual property holders through its policy.²¹¹ The policy not only addresses "name squatting" issues, but also addresses impersonation issues, its copyright policy, and the procedures the site uses to comply with the DMCA "take down notice" requirements.²¹² Next, the terms of service forbid any use of trademark material for financial gain that may mislead or confuse others.²¹³

Twitter's policy now reads:

Twitter pledges to immediately suspend accounts with clear intent to mislead others, even if there is no trademark infringement. *** If the owner shows that the infringer had a clear intent to mislead people into believing a user account is affiliated with a particular company, Twitter will permanently suspend the infringer's account.²¹⁴

Finally, Twitter promises that after mark owners report trademark violations, through Twitter's website support page, they will respond to the report within twenty-four hours.²¹⁵ Despite requir-

210. See Lisa Greenwald-Swire & Matthew L. Levine, *Cost – Effective Enforcement Strategies For a Challenging Economy*, 984 PLI/PAT 707, 716-17 (2009) (describing Twitter's trademark policy); see also Blog posted by Biz, *Not Playing Ball*, Twitter blog, June 6, 2009, available at <http://blog.twitter.com/2009/06/not-playing-ball.html> (remarking on La Russa's lawsuit against Twitter and recognition by network providers for "an opportunity to improve Twitter user experience and clear up confusion beyond simply removing impersonation accounts once alerted" through launching "Verified Accounts Beta"); Maury Brown, *In Wake of La Russa Suit, Twitter Set to Role Out Verification System*, June 18, 2009, http://www.bizofbaseball.com/index.php?option=com_content&view=article&id=3344:in-wake-of-la-russa-suit-twitter-set-to-role-out-verification-system&catid=60:internet&Itemid=125 ("Twitter is in the midst of Beta testing a verification system in an effort to thwart fake Twitter profiles. The addition of the system comes in the wake of a suit by . . . Tony La Russa.").

211. See Greenwald-Swire, *supra* note 210, at 716-17 (describing Twitter's trademark policy).

212. Twitter Support :: Impersonation, Trademark, and Terms of Service Policies, <http://twitter.zendesk.com/forums/26257/entries> (last visited Oct. 4, 2009) (providing list of links addressing Twitter's policy on different issues including impersonation, trademark infringements, and other terms of service).

213. See Twitter Trademark Policy, *supra* note 8 ("Using accompany or business name, logo, or other trademark protected materials in a manner that may mislead or confuse others or be used for financial gain may be considered trademark infringement.").

214. Greenwald-Swire, *supra* note 210, at 717.

215. See *id.* at 716-17 (discussing Twitter's trademark policy).

ing more formality, Twitter's take on copyright infringement follows the same line as its policy with trademark infringement.²¹⁶

Second, Twitter has added an optional protection measure, still in testing stages, called a "verified account."²¹⁷ This new system places a "verified account badge" on a site page after Twitter has contacted the registering person or entity and has proven that the account belongs to that person or entity.²¹⁸ The badge will allow Twitter members to "easily see which accounts. . . are authentic."²¹⁹ So far, Twitter is only verifying a select group of celebrities and extremely well known accounts that "have had problems with impersonation or identity confusion" but has not yet branched out the verification to businesses.²²⁰ Through both policies, Twitter has followed the leads of other social networks by incorporating protections into its terms of service.²²¹

IV. CONCLUSION: LOOKING FORWARD - ARE SOCIAL NETWORKS "TWEETERING" ON THE EDGE?

As shown through judicial history, social networks have been afforded considerable protection on many occasions.²²² Interestingly, courts have accepted, and even encouraged, high levels of self-regulation because of these expanded protections.²²³ As noted earlier, however, there may still be a loophole to establish liability on social networks when approached with cases of trademark in-

216. See Twitter Support :: Filing a Copyright Complaint or DMCA Take Down Notice, <http://twitter.zendesk.com/forums/26257/entries/15795> (last visited Oct. 4, 2009) (requiring procedures including filing complaint electronically via email as well as physical filing via fax or mail, and requires formal filing procedures including ticket numbers).

217. Brown, *supra* note 210.

218. See Twitter.com, Verified Account, <http://twitter.com/help/verified> (last visited Oct. 4, 2009) [hereinafter Twitter Verified Account] (discussing point of new verified account badges).

219. *Id.* Twitter maintains, "This . . . does not mean that accounts without the 'Verified Account' badge are fake. The vast majority of accounts on the system are not impersonators, and we don't have the ability to check 100% of them." *Id.*

220. *Id.* Although Twitter has not begun using this feature for businesses, the site is open to the requests to possibly expanding the 'Verified Badge' to those businesses seeking protection. See *id.* (discussing Verified Badge expansion).

221. Compare Twitter.com, Twitter/Terms of Service, <http://twitter.com/tos> (last visited Oct. 4, 2009) [hereinafter Twitter TOS] (providing all terms of service related to use of Twitter by users), with Facebook TOS, *supra* note 125 (enumerating all terms of service relating to use of Facebook by users).

222. For a further discussion of social network protections, see *supra* notes 67-83 and accompanying text.

223. See Horton, *supra* note 31, at 1305 ("[T]he CDA's purpose is to promote self-help on the Internet and prevent the potential chilling effect that regulation may have on Internet speech.").

fringement.²²⁴ This loophole has grave implications of counter-acting age-old rationales of law defining cases.²²⁵ Therefore, future court outcomes on these types of cases have great potential to create less ambiguity surrounding legal Internet use and liability.²²⁶

Finally, courts may take a similar stance on trademarks in post-domain paths as they did when affording protections to social networks.²²⁷ The same courts that decided to relieve social networks from liability, because of the “chilling effect” on First Amendment freedom of speech rights on the Internet, may take the same view when assessing liability under the ACPA and UDRP concerning post-domain paths containing trademarks.²²⁸

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224. For a further discussion of social network liability, see *supra* text and accompanying note 57.

225. For a further discussion of social network loopholes, see *supra* text and accompanying notes 180-183.

226. For a further discussion of unchartered legal issues on internet use, see *supra* text and accompanying note 41.

227. *See id.* (discussing court rationale for allowing immunities to social networks).

228. For a further discussion of social networks and broad liability relief, see *supra* text and accompanying note 70.

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